

REMARKS

Applicant has amended claim 12 and added two new claims 51, 52. The new claims are supported in the application at, for example, Figure 16B and the corresponding text.

Priority

Regarding the priority information, Applicant directs the Examiner's attention to the communication submitted on August 6, 2004. Page 15 of the communication provides a list of copending applications. Additionally, the IDS submitted at the same time lists various patents that are owned by Applicant.

Claim Rejections under Title 35 USC §102

Claims 12 and 22-25 stand rejected under Section 102 as being anticipated by US Patent Number 5,334,193 to Nardella.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Amended claim 12 recites that the active electrode is positioned on a distal end of an elongate member and is distal to the coil. Nardella does not disclose this claim limitation.

Regarding US Patent No. 5,403,311 to Abele, Abele does not disclose an open tubular-shaped return coil. Abele shows in Figures 6-8 a catheter having a rounded end. Electrodes 58, 60 surround the catheter body. Abele thus does not disclose an open return coil.

Regarding US Patent 5,507,743 to Edwards, Edwards also does not disclose all claim limitations found in claim 12. In particular, Edwards does not disclose the active electrode being distal to the return coil. The active electrode 12 is situated within the helical indifferent electrode 14 in Edwards. This configuration serves the application specified in Edwards, namely, to treat a tumor. The active electrode 12 of Edwards penetrates the tumor and treats the tumor along the active electrode length. This geometry is thus different than that recited in claim 12. Claim 12 of the subject application requires that the active electrode is distal to the return coil.

Regarding US Patent 6,837,888 to Ciarrocca, Applicant disagrees with the Office Action statement that the instant application is not entitled to priority of the previous filed provisional

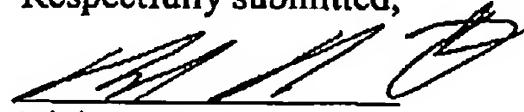
application 60//299,094. In particular, the above referenced provisional application provides the identical Figure 16B that is elected in the instant case. The subject matter of the instant case is therefore supported by the earlier provisional. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Finally, regarding the Section 103 rejection, Applicant submits the asserted references do not cure the deficiencies identified above. Reconsideration and withdrawal of the Section 103 rejections is requested.

CLOSING COMMENTS

Applicant has made a sincere effort to respond to each of the issues raised in the Office Action. If a telephone conference would expedite prosecution of this Application, please telephone the undersigned at the below listed number.

Respectfully submitted,



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